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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,076	08/02/2001	Steven A. Weiss	31069-pa	7991

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EXAMINER

NGUYEN, KIM T

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,076

Applicant(s)

WEISS ET AL.

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/22/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Applicant's election with traverse in the Response to Restriction Requirement and an preliminary amendment filed on August 22, 2002 (paper No. 10) are acknowledged. Currently, applicant elects species 2, claims 13 and 14, and claims 15-24 have been added. By the election and the preliminary amendment, claims 13-24 are examined in this office action, and claims 1-24 are pending.

Drawings

1. The drawings are objected to because:
 - a) Fig. 5 does not include the "stepping motor 62" as disclosed in the specification page 10, line 13, and page 11, line 2.
 - b) Figs. 1-3 do not include the "stepping motor 60" as disclosed in the specification page 10, line 18, and page 11, line 10.
 - c) Figs. 1-3 do not include the "fan 68" as disclosed in the specification page 10, line 20.
 - d) Fig. 1-3 do not include the "processor 64" as disclosed in the specification page 10, line 26, and page 11, lines 1, 5, 10, and 13.
 - e) The "comparator 66" as disclosed in the specification page 11, line 5, is not found in the drawings.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:
 - a) In the specification page 2, lines 1-2, the disclosed "This application is a continuation-in-part of U.S. Serial No. 08/950,280, filed October 14, 1997, pending." should be corrected to "This application is a continuation- in-part of U.S. Serial No. 08/950,280, filed October 14, 1997, now abandoned."
 - b) The use of legal phraseology "means" in the abstract, lines 1-4, should be avoided.

Claim Objections

3. Claim 16 is objected to because of the following informalities:

In claim 16, line 1, the claimed limitation "wherein comparator means are provided assessing outcomes" should be corrected to "further comprising comparator means for assessing outcomes". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 13 is rejected as being subjected to an undue breadth rejection under 35 U.S.C. 112, first paragraph. Claim 13 appears to cover every conceivable structure for constructing the gaming device. The gaming device of claim 13 includes only one multiple reel display, the display itself can not be a complete gaming device; further, claim 13, line 1, claims "A gaming device, comprising, in combination", claim 13 claims only one display element. Claim 13 does not claim any element that should be in combination with the display as asserted by the preamble.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

→ 5. Claims 17-20 and 24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey

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to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a) The specification does not disclose the limitation “a multiplier of said face value on an unrelated amount” in claim 17, lines 3-4; the limitation “said multiplier is an integer” in claim 18; the limitation “said multiplier is a fraction” in claim 19; and the limitation of claim 24.
- b) Claim 20 is rejected as being dependent on the rejected base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morro et al (US. Patent No. 5,947,820).

a. As per claim 13-15, Morro teaches a gaming device which comprises a multiple reel display 604 (Fig. 6) having N reels 204 (Fig. 6) and M wheels 602a-602c (Fig. 6). Morro does not teach associating one wheel with on reel and an outcome of each reel enables its respective wheel. However, Morro teaches enabling a wheel according to an outcome of a reel (col. 5, lines 53-57). It would have been obvious to a person of ordinary skill in the art at the time the

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invention was made to extent the method of activating a wheel according to the outcome of a reel to associate each wheel to each reel, respectively, and to activate a wheel according to the outcome activity of its associated reel in order to provide the capability to control individual wheel using individual reel, since extending associating individual elements requires only routine skill in the art. Further, as to claim 14, Morro teaches receiving a wager (col. 4, lines 39-42).

b. As per claim 16 and 21, Morro teaches providing means for enabling further award based on an outcome on the wheel (col. 8, lines 60-66).

c. As per claim 17-19, Morro teaches displaying a present payout (col. 9, lines 5-10).

Further, providing a multiplier, which is an integer or a fraction, of a face value would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a multiplier of a face value to the awarding display system of Morro in order to display a large award value with a few number of LED of the display.

d. As per claim 20, Morro does not teach including a wheel larger than the M wheels and arranging the larger wheel above the M wheels. However, Morro teaches an arrangement in which one wheel is placed on top of another (Fig. 6). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to resize the top wheel 602c (Fig. 6) of Morro so that the top wheel is larger than other wheels, since resizing a display object on the display requires only routine skill in the art.

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- e. As per claim 22, Morro teaches including enabling chance means for a further award (col. 8, lines 35-37).
- f. As per claim 23-24, refer to discussion in claims 17-19 above.

Response to Arguments

Applicant's election with traverse of species 2 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the statutory requirement under 35 U.S.C. 121 has not been met. This is not found persuasive because the specification clearly discloses two distinctive embodiments, the first embodiment is illustrated in Figs 1-3 (specification page 10, lines 7-16), and the second embodiment is illustrated in Figs. 6 and 7 (specification page 11, last two paragraphs), since the two embodiments are distinctive and exclusively independent, the statutory requirement under 35 U.S.C. 121 is met.

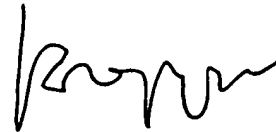
The requirement is still deemed proper and is therefore made FINAL.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 7:30AM to 5:30PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 872-9302.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to read 'Kim Nguyen', with a horizontal line underneath the name.

Kim Nguyen
Patent Examiner
November 12, 2002